

### **Remarks**

The Application has been reviewed in light of the Official Action of November 1, 2006. Claims 1, 3 and 17 have been amended. Claim 2 has been cancelled. Claims 1 and 3-17 are pending in the Application.

No new matter is introduced by the amendments as they correspond to matter already presented in the claims.

The Examiner rejected claim 1 under 35 U.S.C. 102(b) as being anticipated by Rodriguez (US 2,861,170). The Examiner rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over Rodriguez in view of Winter et al. (US 6,628,894). The Examiner rejected claims 2 and 4-6 under 35 U.S.C. 103(a) as being unpatentable over Rodriguez in view of Alston et al. (US 4,947,025). The Examiner rejected claims 3, 8 and 12-17 under 35 U.S.C. 103(a) as being unpatentable over Rodriguez in view of Alston and in further view of Winter. The Examiner rejected claims 9-11 under 35 U.S.C. 103(a) as being unpatentable over Rodriguez in view of Nelson (US 4,974, 551) and Twigg (US 5,853,553).

Applicants request that the Examiner reconsider the rejection of claims 1, 12, and 17 because these claims require a “housing adapted to directly hold water and to transport water stored therein; ... a heating element adapted to heat water inside the housing; [and] an adjustable thermostatic control controlling the output of the heating element[.]”

In order for the claimed invention to be obvious over the prior art, there must be some teaching, suggestion or motivation in the cited references to modify or combine the references in accordance with the claimed invention. See, MPEP §2143; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). Further, the prior art references must teach or suggest all of the claim limitations. See MPEP §2143.

Rodriguez is directed to a water heating attachment for cold water pipes that is fixed to a pipe for support. (col. 1, l. 71-72; col., 2 l. 2-3.) Rodriguez expressly states that the objective is to "simplify the construction so that a single manually operated valve will shut off the water or will turn on cold water, or warm water, or hot water as selected by the operator." (col. 1, l. 19-23). Rodriguez further expressly states that the objective is "to provide a simplified electrical control for an electric water heater." (col. 1, l. 27-29). To this end, Rodriguez goes to great lengths to describe a valve assembly 20 that directs a portion of the cold water introduced from arm 29a into tank 15 and the other portion of the cold water into the other arm 29c. (col. 2 l. 65 – col. 3 l. 2). Tube 44 combines the water heated in tank 15 with the cold water in arm 29c. (col. 2 l. 65 – col. 3 l. 2). Turning valve 20 alters the amount of cold water mixed. (col. 4, l. 15-18). Rodriguez states that the ability to mix hot and cold water "is an important feature of my invention." (col. 3 l. 2). The valve is activated by lever 52, which is described as providing "a long arm that is curved to conform generally to the outer surfaces of the shower attachment and extends down alongside the tank but slightly spaced therefrom; see Figs. 2 and 3." (col. 3 l. 21-24). Rodriguez discloses a thermostat 66 that "is a safety device which acts automatically to open the circuit of the heating coil 30 whenever the temperature of the valve chamber rises to a predetermined point." (col. 3 l. 64-67). Further, Rodriguez discloses that tank 15 is capable of holding two-gallons of water while attached to the supply pipe. (col. 4, l. 26-30).

Alston discloses a portable electric water heater with a coiled water conducting tube 29 that extends from the aft end of housing 11 through the forward end of housing 11. (col. 2, l. 39-56). An electrical resistance heating element 30 encircles each coil of conducting tube 29. (col. 2, l. 39-56). A rheostat 44 that controls the amount of current applied to the electrical resistance heating element 30. (col. 3, l. 12-14). The rheostat 44 enables water of different temperature levels to be dispensed by the water heater. (col. 3, l. 30-32). Alston expressly teaches that the benefit of its system is that it is light do to the fact that "no water is stored within the coiled water conducting tube during periods of non-use[.]" (col. 1, l. 57-59).

Applicant respectfully submits that the claimed invention is not obvious over the cited references because one skilled in the art would not be motivated to modify or combine these references in accordance with claims 1, 12, or 17. Applicant submits that one skilled in the art would not be motivated to combine Rodriguez with Alston in accordance with the claimed invention because such a combination would be directly contrary to the teachings of Rodriguez and Alston.

As noted above, Rodriguez expressly states that the ability to control the temperature of the water using the valve system is an important feature of the invention. Further, Rodriguez expressly states that the objective of the disclosure is to provide a device with simplified electrical control. In furtherance of these objectives, Rodriguez discloses a device with a valve that mixes cold water with hot water and a thermostat that operates as a high temperature shutoff element when the hot water temperature reaches a predetermined point. Thus, Rodriguez teaches away a portable water heating system with a "housing adapted to directly hold water and to transport water stored therein; ... a heating element adapted to heat water inside the housing; [and] an adjustable thermostatic control controlling the output of the heating element[.]"

Alston on the other hand discloses a portable water heater with a rheostat that is coupled to a heating element that surrounds coiled tubes. The rheostat and heating element are the only means by which the temperature of the water dispensed by the water heater is controlled. Alston expressly states that the benefit of its water heating system is that it does not store water, enabling the device to be light weight. Rodriguez on the other hand discloses a device that does have the ability to store up to two gallons of water. If one skilled in the art were to apply Rodriguez to Alston, based on the teachings of Alston, the ability to store water would be eliminated. Thus, Alston also teaches away a portable water heating system with a "housing adapted to directly hold water and to transport water stored therein; ... a heating element adapted to heat water inside the housing; [and] an adjustable thermostatic control controlling the output of the heating element[.]"

Applicant submits that since the objectives of Rodriguez and Alston are completely distinct, it is entirely uncertain what combination would result, if any combination would in fact be made. Rodriguez teaches a shower attachment that controls water temperature using a valve system, stores water, and only uses a thermostat as a high temperature cutoff. Alston teaches a portable water heater that benefits from the lack of storing water and only controls temperature using a heating element that surrounds water tubes and a rheostat. Both references disclose devices with characteristics that are expressly disclaimed by the other reference. In view of these references' inherent distinctiveness, Applicant submits that they would not and do not provide any teaching, suggestion or motivation to combine the references in accordance with claims 1, 12 or 17.

In view of the foregoing amendments and remarks, it is respectfully submitted that all of the claims currently pending in the application are now in condition for allowance. Reconsideration and notice to that effect is earnestly requested.

Respectfully submitted,

/Wesley W. Whitmyer, Jr./

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